## REMARKS

Claims 1 and 3-23 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 5,506,035, hereinafter *Van Phan*. The Examiner alleges that *Van Phan* discloses the claimed liquid permeable surface, a substantially liquid impermeable surface, and an absorbent structure contained therein.

With regard to the claimed Gurley stiffness value (lower than 1,000 mg), the Examiner's position continues to be that *Van Phan* does not disclose the claimed Gurley stiffness value. Instead, the Examiner alleges that the claimed stiffness value is inherent in the structure taught by *Van Phan*. The Examiner states that it is reasonable to presume that a reference with the structural limitations of the claims inherently possesses the desired properties or that these properties would be obvious to *Van Phan* because *Van Phan* uses like materials. The Examiner further asserts that it is Applicants' burden to show a side-by-side comparison between a product produced according to the presently claimed invention and the product disclosed by *Van Phan*. This rejection is respectfully traversed.

The Examiner relies on §§ 2112 and 2112.01 of the MPEP to prove inherency. However, § 2112.01 states that "When the PTO shows a ***sound basis*** for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." (emphasis added) Given the numerous differences between the process of making the *Van Phan* product and the claimed product (which were described in the prior response), the Examiner cannot have a sound basis for believing that the products are the same.

Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness based upon inherency. "Inherency… may not be established by probabilities or possibilities." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). The Examiner must provide a reasonable factual basis that the "allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *See Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Nevertheless, even following the teachings of *Van Phan* would not result in a product meeting the present claims. MPEP § 2141.02.VI require the Examiner to consider portions of a reference that teach away from the presently claimed invention. *See also W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert denied*, 469 U.S. 851 (1984). In that regard, *Van Phan* teaches away from the claimed invention. Specifically, *Van Phan* does not suggest the particularly claimed stiffness values and density. To the contrary, in a section entitled "FOAM DENSITY," beginning at Col. 29, *Van Phan* teaches away from the claimed density by way of the following statements:

- "In general, for a given surface area to mass ratio and cell size, as the foam density decreases, the osmotic absorptive rate and capillary absorptive capacity will increase. Importantly, the density of the superabsorbent polymer foams can also determine the cost effectiveness of the absorbent articles herein." Col. 29, ll. 25-30.

- "This type of density determination method can be useful for characterizing **very low density foams such as the foams herein** wherein the dry density approximates the inverse of the pore volume of the foam." Col. 29, ll. 54-58 (emphasis added).

• "It is generally preferred to **minimize the density** of the superabsorbent polymer foams consistent with obtaining a foam which has a desired structure of intercommunicating channels, cell size, and surface area to mass ratio." Col. 29, ll. 64-67 (emphasis added).

• "The superabsorbent polymer foams of the present invention will typically have dry basis density values which range from about 0.1 to about 0.5 g/cm$^3$." Col. 30, ll. 21-24.

• "It is generally desirable to maximize the pore volume [*i.e.*, the approximate inverse of the density] of the foams herein." Col. 31, ll. 3-4.

Thus, one skilled in the art, upon reviewing *Van Phan*, would be led to believe that optimization of foam density occurs at densities lower than the claimed values. Accordingly, Applicants respectfully disagree with the Examiner's assumption that one skilled in the art would readily discover the presently claimed invention as routine optimization of a result effective variable, *e.g.*, by manipulating the level of the blowing agent. If anything, *Van Phan's* emphasis on lower densities would teach one away from the claimed invention.

The Examiner's attention is further directed to *In re Rijckaert*, wherein the Federal Circuit overturned a rejection based on inherency allegedly due to condition optimization. *See In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *see also* MPEP § 2112.IV.

Furthermore, Applicants reiterate their position that *Van Phan* provides no guidance whatsoever with regard to the presently claimed Gurley stiffness values. (In fact, *Van Phan* simply states that the product should be flexible, defined rather loosely as able to "conform to the general shape and contours of the human body."

*See* Col. 32, ll. 30-32). In contrast, the present specification provides detailed teachings as to how one of ordinary skill in the art can make the claimed invention. *See, e.g.*, paragraphs [0027], [0028], [0038], and [0039]. Although the presently claimed invention is clearly not limited to the disclosed embodiments, the specification of the presently claimed invention provides considerable detail as to some of the types of constructions that would result in a product having the claimed Gurley stiffness.

Applicants therefore respectfully submit that *Van Phan* does not disclose or render obvious a product of the presently claimed invention. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection based on *Van Phan*. In the event that there are any questions concerning this response, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Respectfully submitted,

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